



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/012,204 | 10/30/2001 | Brock W. Callen | 10180-002003 | 5770 |

26161 7590 01/20/2004

FISH & RICHARDSON PC
225 FRANKLIN ST
BOSTON, MA 02110

| |
|----------|
| EXAMINER |
|----------|

HAYES, JOHN W

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

3621

DATE MAILED: 01/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/012,204

Applicant(s)

CALLEN ET AL.

Examiner

John W Hayes

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 32-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 32-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 October 2001 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Status of Claims

1. Applicant has amended claims 32-33 in the amendment filed 06 October 2003. Claims 1-31 were previously canceled. Thus, claims 32-34 are the only claims that remain pending.

Response to Arguments

2. Applicant's arguments filed 06 October 2003 have been fully considered but they are not persuasive.

3. Applicant has amended claims 22, 28 and 31 in an effort to overcome the 35 USC § 101, however, these amendments do not overcome the rejection for the following reasons.

With respect to claims 32-34, applicant argues that the claims have been amended to be within the technological arts. Examiner respectfully disagrees and submits that the claimed invention must utilize technology in a non-trivial manner. Furthermore, the claims merely state that a computer is used to store information, however, do not recite or suggest that the computer is being used to carry out any of the processing steps such as reducing a durational risk, providing a prescribed interaction or matching the stored information. Examiner submits that, in the broadest reasonable interpretation of the claim language, these steps may be carried out manually by a human using information that is merely stored in a computer.

Furthermore, although the claim states that the durational risk is reduced, there still does not appear to be a concrete result. The durational risk does not appear to be a concrete number or other result that is a result of some particular calculation or algorithm performed by the computer, and therefore, is not directed to statutory subject matter.

4. Applicant's arguments with respect to the prior art rejections are moot based on the new grounds of rejection.

However, with respect to claim 32, applicant argues that neither Parrish et al nor Feldman discloses or suggests the use of a prescribed interaction with terminated employees. Examiner

Art Unit: 3621

respectfully disagrees and submits that Parrish et al discloses a prescribed interaction by teaching that the system is used to intake information based on an interview and discussion with the participant (Col. 3 line 55-Col. 4 line 5) and further teaches a plurality of preselected parameters with a preferential weight associated with each parameter. Examiner submits that interviewing the participant using a computer is an example of a step-by-step prescribed interaction.

With respect to claim 33, applicant argues that neither Parish et al nor Feldman discloses or suggests matching of qualifications and available jobs. Examiner disagrees and submits that Parish et al disclose a database which is populated with open employment positions and the various skill levels identified with each open employment position (Col. 5, lines 18-25) and further matching of a persons skills with those required by the open position (Col. 6, lines 7-29)

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 32-34 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

Art Unit: 3621

In the present case, claims 32-34 only recite an abstract idea. The recited steps of merely storing information related to interactions with terminated employees, providing a prescribed interaction and storing the results does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. These steps only constitute an idea of how to accumulate and store information related to a terminated employee.

As to technological arts recited in the preamble, mere recitation in the preamble (i.e., intended or field of use) or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea unless there is positive recitation in the claim as a whole to breathe life and meaning into the preamble. In the present case, none of the recited steps are directed to anything in the technological arts as explained above with the exception of the recitation in the preamble that the method is a "computer based method". Looking at the claim as a whole, nothing the body of the claim recites any structure or functionality to suggest that a computer performs the recited steps. Therefore, the preamble is taken to merely recite a field of use.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. An invention, which is eligible or patenting under 35 U.S.C. 101, is in the "useful arts" when it is a machine, manufacture, process or composition of matter, which produces a concrete, tangible, and useful result. The fundamental test for patent eligibility is thus to determine whether the claimed invention produces a "use, concrete and tangible result". The test for practical application as applied by the examiner involves the determination of the following factors"

(a) "Useful" – The Supreme Court in *Diamond v. Diehr* requires that the examiner look at the claimed invention as a whole and compare any asserted utility with the claimed invention to determine whether the asserted utility is accomplished. Applying utility case law the examiner will note that:

- i. the utility need not be expressly recited in the claims, rather it may be inferred.
- ii. if the utility is not asserted in the written description, then it must be well established.

(b) "Tangible" – Applying *In re Warmerdam*, 33 F.3d 1354, 31 USPQ2d 1754 (Fed. Cir. 1994), the examiner will determine whether there is simply a mathematical construct claimed, such as a

Art Unit: 3621

disembodied data structure and method of making it. If so, the claim involves no more than a manipulation of an abstract idea and therefore, is nonstatutory under 35 U.S.C. 101. In *Warmerdam* the abstract idea of a data structure became capable of producing a useful result when it was fixed in a tangible medium, which enabled its functionality to be realized.

(c) "Concrete" – Another consideration is whether the invention produces a "concrete" result.

Usually, this question arises when a result cannot be assured. An appropriate rejection under 35 U.S.C. 101 should be accompanied by a lack of enablement rejection, because the invention cannot operate as intended without undue experimentation.

In the present case, the claimed invention stores information related to interactions with a terminated employee and stores information related to available jobs that may be useful in placing the employee in a new job (i.e., repeatable), however, this information does not appear to be concrete since the result cannot be assured. There is no indication or limitation in the claim that would suggest the type of information that is accumulated in order to make the stored results concrete. Also, this information is stored, however, does not appear to be provided to any individual or activity in order to realize some practical application of the invention and, therefore, appears to be an abstract idea. Furthermore, although the claims state that the durational risk is reduced, there still does not appear to be a concrete result. The durational risk does not appear to be a concrete number or other result that is a result of some particular calculation or algorithm performed by the computer, and therefore, is not directed to statutory subject matter. Thus, for these reasons, claims 32-34 are deemed to be directed to non-statutory subject matter.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3621

8. Claims 32-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parrish et al, U.S. Patent No. 5,416,694 in view of Feldman et al, "Managing Layoffs: Experiences at the Challenger Disaster Site and the Pittsburgh Steel Mills" and Lee, "Outplacement: Throwing Them Life Preservers"

As per **Claims 32-34**, Parrish et al disclose storing information about the qualifications of an employee planning an occupational readjustment (Figure 1; Col. 3, lines 40-45; Col. 5, lines 50-63); providing a prescribed interaction such as an interview to accumulate information useful in placing the employee in a new job (Col. 3, line 55-Col. 4 line 5) and assembling and storing this information (Col. 5, lines 50-63), storing information about available jobs (Col. 3 line 65-Col. 4 line 5; Col. 5, lines 17-25) and matching the stored information (Col. 1, lines 60-68; Col. 2, lines 20-25 and 47-52; Col. 5, lines 18-25; Col. 6, lines 7-30).

Parrish et al, however, fail to explicitly disclose that the method is used for employees that have been non-voluntarily terminated. Feldman et al disclose that terminated employees should be provided with outplacement assistance such as career counseling sessions and direct placement assistance to help employees locate job opportunities (Pages 4-5). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Parrish et al and include this type of job placement service for employees that have been terminated. Parrish et al indicates that the invention is used for occupational readjustment suggesting that it may be used for employees that have lost a job or are looking for a job for various reasons. Feldman et al also provides motivation by indicating that providing outplacement services would help minimize the negative effects of layoffs on both the employees and the organization (Pages 1-2).

Parish et al further fail to disclose reducing a durational risk associated with benefits to be paid under an insurance product that provides termination benefits to employees who are non-voluntarily terminated from employment by an employer. Lee discloses that outplacement services benefit terminated employees. Outplacement services provides counseling, skills assessment, assistance in resume preparation, job search skill planning along with other services that help terminated employees find a new job. Lee further teaches that these services tend to help employees find new jobs faster than

Art Unit: 3621

they would on their own, thereby reducing continuing pay and insurance benefits costs to employers. It would have been obvious to one having ordinary skill in the art at the time of applicant's invention to modify the method of Parish et al and include outplacement services as part of an insurance product to provide termination benefits and to use outplacement services in an effort to reduce the benefits that would be paid as taught by Lee.

Conclusion

9. Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Art Unit: 3621

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- McGovern et al disclose an employment recruiting system and teach a method of monitoring employment advertisements for a job seeker and automatically notifying the job seeker when a position is suitable
- Walker et al disclose a method for establishing anonymous communications between job seekers and employers seeking job applicants
- Clark et al disclose an automated method for selecting personnel matched to job criteria
- Nobile "Outplacement Counseling: Minimizing Legal Liability" discloses providing outplacement services to terminated employees including job search strategies for ultimately landing a new position
- Mishra et al, "Preserving Employee Morale During Downsizing" disclose that providing outplacement services such as job placement and job bank services helps to preserve employee morale.
- Lisoski, "When Layoffs are Inevitable – Do Them Right", discloses providing job assistance to terminated employees such as effective job searching techniques, career counseling and providing assistance in finding new employment.

Art Unit: 3621

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hayes whose telephone number is (703)306-5447. The examiner can normally be reached Monday through Friday from 5:30 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Trammell, can be reached on (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Any response to this action should be mailed to:

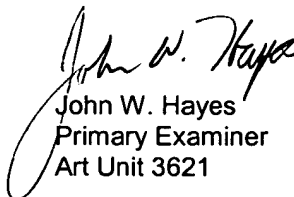
***Commissioner of Patents and Trademarks
Washington D.C. 20231***

or faxed to:

(703) 872-9306 [Official communications; including
After Final communications labeled
"Box AF"]

(703) 746-5531 [Informal/Draft communications, labeled
"PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington,
VA, 7th floor receptionist.


John W. Hayes
Primary Examiner
Art Unit 3621

January 12, 2004